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OFFICE OF PETITIONS

In re Application of :
Deaddio et al. :
Application No. 09/127,341 : ON PETITION
Filed: 07-31-1998 :
Attorney Docket No. 11021.0001 :

This is a decision on the petition under 37 CFR 1.137(a), filed on October 13, 2006, to revive the above-identified application.

The application became abandoned on July 31, 2006, for failure to file a proper and timely reply to the final Office action mailed on January 30, 2006, which set a three (3) month shortened statutory period for reply. On July 27, 2006, petitioners submitted an amendment in response to the final Office action and a request for an extension of time for response within the third month. The Examiner found that the amendment did not *prima facie* place the application in condition for allowance. An Advisory Action was mailed on September 8, 2006. A Notice of Abandonment on September 22, 2006. On October 13, 2006, petitioners filed the present petition and a Request for Continued Examination (RCE).

In the present petition, petitioners stated that in response to the final Office action their attorney held two telephone interviews with the Examiner on July 19, 2006, and July 27, 2006. Petitioners asserted that during the second interview, the Examiner agreed to allow the entry of the amendment and withdraw the final rejection, as well as requested that the attorney file a statement of the substance of the interview in the next submission. Petitioners indicated that based on the outcome of the second interview, they submitted an amendment in response to the final Office action. Petitioners averred that the delay was unavoidable because they relied on their agreement with the Examiner and believed that the final Office action would be withdrawn. Petitioners contended that they were unaware of anything contrary to the agreement made during the second interview until receipt of the Advisory Action, and therefore, they could not file another reply before the expiration of the six-month statutory period.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(d).

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[1] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[3] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding

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[1] 35 U.S.C. § 133.

[2] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[3] See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[4]

A response to a final Office action may be entered if it presents an amendment that *prima facie* places the application in condition for allowance. However, the admission or refusal to admit any amendment after final, and any related proceedings, will not operate to relieve the application from its condition subject to appeal or save the application from abandonment under 37 CFR 1.135.[5] The entry of an after-final amendment **is not a matter of right**, and it is incumbent upon an applicant to take steps to ensure against abandonment of an application. Moreover, "a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985)." MPEP 711.03(c)(II)(C)(2).

In the present case, the file record reveals that petitioners did not take appropriate action to ensure that a proper response was timely filed so as to prevent the application from becoming abandoned. It is regrettable that the Office did not mail an Advisory Action until after the six month statutory period ran; however, it is evident from 37 CFR 1.116 that abandonment of an application is risked when an amendment after a final Office action is filed. Furthermore, petitioners filed the reply to the final Office action on July 27, 2006, leaving only three days before the six-month statutory period expired. An applicant may delay action until the end of the time period for reply; however, the applicant must assume the risk attendant to such delay.[6]

Abandonment takes place by operation of law for failure to submit a timely and proper reply to an Office action, not by the mailing of an Office communication, such an Advisory Action.[7] As previously stated, 37 CFR 1.116 and 1.135(b) clearly indicate that the mere filing of an amendment does not save the application from abandonment. Rather, the filing of a Notice of Appeal, RCE accompanied by a proper submission, or a continuing application guarantees the pendency of the application, not filing an amendment after final rejection. Thus, the application became abandoned due to petitioners' failure to file a Notice of Appeal, RCE and submission, or continuing application prior to the expiration of the time period for reply to the final Office action and not because of a delay in the mailing the Advisory Action or any other error on the part of the USPTO.

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[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

[5] See 37 CFR 1.116.

[6] See Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

[7] MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

CONCLUSION

Petitioners have not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Accordingly, the petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

ALTERNATIVE VENUE

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioners are not precluded from seeking relief by filing a petition under 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

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